APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/155,327	03/29/1999	SUZANNE CORY	11686	8469

7590   07/01/2002

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EXAMINER
KAUSHAL, SUMESH

ART UNIT	PAPER NUMBER
1636	

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _09 April 2002_ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _21-24_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _21-24_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _23 January 2002_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☒ All b) ☐ Some * c) ☐ None of:

         1. ☒ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/155,327 has been entered.

Claims 1-4 were canceled.

Claims 21-24 were newly filed.

Claims 21-24 were pending and were examined in this office action.

▶ *If the claims are amended, added and/or canceled in response to this office action the applicants are required to follow Amendment Practice under 37 CFR § 1.121 (http://www.uspto.gov) and* A CLEAN COPY OF ALL PENDING CLAIMS IS REQUESTED.

Specification

The amendment filed 01/23/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The newly submitted sequence listing is not supported by the specification as originally filed *(see rejection under 35 USC 112 1st para).*

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 01/23/02 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of changes made the nucleotide/amino acid sequence in figure 9A and 9B *(see rejection under 35 USC 112 1st para)*.

Any proposal by the applicant for amendment of the drawing to cure defects must be embodied in a separate letter. Otherwise the application, unless in other respects ready for issue, cannot be corrected, and applicant must be so advised in the next action by the examiner (see MPEP 608.02(r).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claims are drawn to a isolated nucleic acid molecules which encodes the amino acid sequences of SEQ ID NO:7 and 9. In addition the claims are drawn to isolated nucleic acid molecules comprising the nucleotide sequences of SEQ ID NO:6 and 8.

The applicant has amended the nucleotide sequences of SEQ ID NO:6 and 8. The applicant has also amended the amino acid sequences of SEQ ID NO:7 and 9. (see response filed on Paper No. 25, 01/08/02). The applicant states that figures 1 and 8 of instant specification and figure 9A-9B of priority documents support these amendment (response, page 3-4).

However, recent amendment to SEQ ID NO: 6, 7, 8 and 9 are not supported WO9735971 (PCT/AU97/00199, filed 03/27/97) and PN8965 filed 03/27/96. The applicant fails to point out where in the figures 1 and 8 of the instant specification there is support for the amendments as proposed. Figure 1 and 8 of instant specification are sequence compression of bcl-w and bcl-2 related amino acid sequences. Similarly the applicant fails to point out where in figure 9A and 9B of PN8965, 03/27/96 there is support for amendment as proposed. Figure 9A and 9B of WO9735971 and figure 9A and 9B of PN8965 are not identical. Furthermore, figure 9A and 9B of WO9735971 are fragments of amino acid sequences (9A i-iv, 9B i-iv), whereas figure 9A (636bp) and 9B(808bp) of PN8965 are nucleotide sequences.

In addition, the instant specification fails to incorporate the priority document (PN8965) by reference. There is no evidence that any information left out of this application was intended to be in the instant application at the time of filing. Therefore, the recent amendment in the SEQ ID NO (s) is considered to be a **new matter**, which cannot be supported by PN8965.

Notice To Comply

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Specifically the application fails to comply with 37 CFR 1.821(d), which states:

(d) Where the description or claims of a patent application discuss a sequence that is set forth in the "Sequence Listing " in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the sequence identifier, preceded by "SEQ ID NO: " in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application (see MPEP 2422.03).

For compliance with sequence rules, it is necessary to include the sequence in the "Sequence Listing" and identify them with SEQ ID NO. In general, any sequence that is disclosed and/or claimed as a sequence, i.e., as a string of particular bases or amino acids, and that otherwise meets the criteria of 37 CFR 1.821(a), must be set forth in the "Sequence Listing." (see MPEP 2422.03).

The instant specification fails to comply with the requirements for patent applications containing nucleotide sequence and/or amino acid sequence disclosures. The specification discloses nucleotide and amino acid sequences in **Figure-1, 8 and 9**. However, these sequences are not identified by sequence identifiers in the brief description of the figures.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. For the response to this office action to be complete, Applicants are required to comply with the Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is (703) 305-6838. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Irem.Yucel can be reached on (703) 305-1998. The fax-phone number for the organization where this application or proceeding is assigned as (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst Zeta Adams, whose telephone number is (703) 305-3291.

S. Kaushal
Patent examiner

SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER